

## REMARKS/ARGUMENTS

Claims 1-12 and 15-22 are pending and stand under a non-final rejection. Applicant respectfully traverses all rejections and requests reconsideration in view of the accompanying amendments and remarks.

Applicant acknowledges that they may reinstate their prior Appeal of this Application at any time by filing an appeal brief addressing pending grounds for rejection according to MPEP §1208.02.

### Amendments

Applicant amends Claim 1 by incorporating the limitation of Claim 5 into Claim 1. Applicant then cancels Claim 5. Applicant further highlights with the amendment that the slit severs the primary face or face opposing the primary surface. The fact that the slit severs the stated face is inherent in the original meaning of traversing the face and penetrating to a specified depth. See, for example, the accompanying support in the specification (page 13, lines 1-9 and element 82 in Figures 2a-2c). The teachings require such a slit to open slightly when the panel bends into a non-planar configuration and the figures specifically show the slit severing a primary surface.

This amendment does not introduce new matter. Furthermore, any new grounds for rejection should not be necessitated by the present amendment since amended Claim 1 is equivalent to original Claim 5, which was considered in all prior searches by the Office.

### Rejection of Claim 5

The present arguments apply to presently amended Claim 1, which is equivalent in claim scope to original Claim 5.

The Office rejected Claim 5 under 35 USC 103(a) as being unpatentable over Walendy et al. (US 5529824, “Walendy”) in view of Ducharme (US5062244). The Examiner asserts that Walendy alone teaches all of the elements of Claim 5, including the slit penetrating to a depth less than the panel thickness that traverses the primary face of the face opposing the primary face of the panel (*see* page 5, lines 1-3 of the Office Action). The Examiner further states that Ducharme teaches a slit satisfying the requirement of Claim 5 and argues that combining Walendy and Ducharme with

the motive to increase insulation value renders the panel of Claim 5 obvious. Since the Examiner seems to argue that Walendy alone has all of the elements of Claim 5 and Walendy in combination with Ducharme provide all of the elements of Claim 5, Applicant will address Walendy alone and in combination with Ducharme.

***In Regards to Walendy***

The Examiner points to Figure 2, Number 2 of Walendy and concludes that Number 2 provides a slit that traverses a primary face (or face opposite a primary face) of a panel. Applicant respectfully disagrees in view of the definition taken from both the Application itself (the primary resource for interpreting a claim) and from a common dictionary. Most evident is the fact that Number 2 of Walendy does not sever a primary face of a panel.

The present Application provides a functional definition to the limitation provided in original Claim 5. Lines 1-9 on page 13 of the Application present the pertinent portion from Claim 5: a “slit traversing a primary face or a face opposing a primary face and extending to a depth less than the panel thickness.” The very next sentence in the Application provides a functional definition for the slit: “*Such slits facilitate bending a building panel into a non-planar configuration* for insertion into a cavity.” Therefore, the slit must facilitate bending of the panel into a non-planar configuration.

The limitation specifically requires that the slit penetrate to a depth less than the panel thickness. That means the slit must “pass into or through” the panel to a depth less than the panel thickness. (*definition of “penetrate” taken from Merriam Webster’s Collegiate Dictionary, copy of which accompanies this response.*).

Furthermore, presently amendment claim 1 specifically highlights the inherent necessity of the slit to sever a primary face (or face opposing a primary face).

Element Number 2 of Walendy does not facilitate bending of the panel into a non-planar configuration; does not pass into or through the panel to a depth less than the panel thickness (it penetrates to a depth almost equal to the width of the panel, a depth that greatly exceeds the panel thickness); and does not sever a primary face of the panel (see definition of primary face from page 4, lines 18-22 of present Application). Nor does Walendy disclose any suggestion or motive to consider such a

slit. As such, Applicant fails to see how Walendy can render original Claim 5 and, in particular, presently amended Claim 1 obvious.

Therefore, Applicant respectfully requests that the Examiner provide specific teaching in Walendy that provides these necessary components of presently amended Claim 1 or acknowledge that Claim 1 is patentable over Walendy.

***In Regards to Walendy in view of Ducharme***

The rejection of original Claim 5 and presently amended Claim 1 in view of a combination of Walendy with Ducharme is improper for at least three reasons: (1) the Office's motivation to combine Ducharme with Walendy is without reasonable support; (2) Applicant fails to find the necessary slit in the panel of Ducharme; and (3) to modify Walendy in the manner suggested would conflict with specific teaching in Walendy.

First, the Office asserts that it would be obvious to provide the panel of Walendy with a slit from Ducharme for the purpose of increasing the insulation value of the panel – pointing to teachings to that effect on column 3, lines 18-19 of Ducharme. With due respect, the teaching of Ducharme says just the opposite – as Applicant has expressed in their response of 26 May 2005 (page 5, last paragraph before SUMMARY). Ducharme teaches that the elimination of gaps (which the Examiner identifies as slits) in the panel by compressing the foam to collapse the gaps increases the insulation (column 3, lines 13-19). Gaps actually decrease the insulation value of the Ducharme panels and it is their elimination that increases the insulation value. Therefore, Ducharme would not motivate anyone with any reasonable skill in the art to put slits (or gaps) into foam to increase insulation properties. As such, the Office's motivation to combine is without reasonable support.

Second, as with Number 22 in Walendy gaps 28 and 29 in Ducharme do not facilitate bending of the panel into a non-planar configuration; do not pass into or through the panel to a depth less than the panel thickness (it penetrates the full length of the panel, a depth that greatly exceeds the panel thickness); and do not sever a primary face of the panel (see definition of primary face from page 4, lines 18-22 of present Application) or face opposing a primary face. Nor does Ducharme disclose any suggest or motive to consider such a slit.

Finally, Walendy requires that Number 2 cut open the panel of Walendy in a transverse direction that is parallel to the transverse direction of the panel (*see*, column 2, lines 56-60). In contrast, the gap in Ducharme does not cut open a panel in a transverse direction that is parallel to the transverse direction of the panel. At best, the gap in Ducharme provides an opening on the ends of the panel, which are perpendicular to the transverse direction of the panel. Therefore, there is no way to replace or modify the slit of Walendy with the gap of Ducharme (if that is what the Examiner is suggesting) without violating a necessary character of the Walendy slit.

Therefore, the proposed motivation to combine Ducharme with Walendy is unreasonable and, even so, fails to provide the slit required by original Claim 5 and presently amended Claim 1. Neither Walendy nor Ducharme suggest or motivate an artisan of ordinary skill in the art to even consider such a slit. As such, Applicant believes original Claim 5, and presently amended Claim 1 is patentable over Walendy and Ducharme, individually or in combination.

All remaining claims depend from amended Claim 1 and, therefore, are narrower in scope than Claim 1. The Office does not assert that the missing elements of Claim 1 are in any of the other cited references. Therefore, Applicant believes all pending claims are patentable for the same reason as Claim 1.

Applicant finds the following claims further patentable over the cited references for the following additional reasons:

Claim 10 specifies a panel with at least one edge that comprises a tongue or groove. To achieve such a panel, the Examiner combines Walendy with Ducharme with a motive to create a Walendy panel that conforms to different sizes and shapes of cement building blocks. However, Walendy's objective is to achieve panels for voids in automobiles (*see* column 1, lines 9-15 and lines 43-57). It is not obvious to extend teachings in regards to cement building blocks to automobiles. Therefore, combining Ducharme with Walendy lacks proper motivation since they are unrelated art-fields.

Claim 18 specifies a panel where at least one panel domain comprises coalesced polymeric foam strands having interstrand spaces. The Office relies on teaching in Park teaching at page 9, line 30. Teaching on that line of text and surrounding lines of text teach extrusion of resin through a multi-orifice die ... "so that contact between adjacent streams of molten extrudate occurs during the foaming

process and the contacting surface adhere to one another with sufficient adhesion to resulting a unitary foam structure.” This teaching does not identify interstrand spaces (places where strands do not touch; voids between strands – *see* page 16, lines 29-34 of Application). In fact, Park teaches just the opposite – strand contact and adhesion. Applicant respectfully requests that he Examiner specifically point out teaching in Park that suggests “interstrand spaces” or withdraw this rejection.

Claim 22 specifies a panel comprising at least two panel domains ... wherein the panel domains extend through the thickness of the panel. As Applicant established in their last response (26 May 2005, page 4 under heading Claim 22; *see also* page 4, lines 33-34 of Application) the thickness of a panel is the “perpendicular distance between a primary face and its opposing face.” Applicant claims that a panel domain extending through the thickness of a panel must extend the perpendicular distance between a primary face and its opposing face. Any other interpretation would fail to constitute a meaningful limitation in the claim. In contrast to the Examiners assertion, Applicant fails to find element 3 of Walendy to extend through the thickness of the panel. Therefore, Applicant believes claim 22 is patentable over the cited references.

For the above reasons, Applicant believes Claims 1-4, 6-12 and 15-22 are patentable over the cited art. Applicant respectfully requests withdrawal of all pending rejections and allowance of Claims 1-4, 6-12 and 15-22 at an early date.

Respectfully submitted,

  
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One entry found for **penetrate**.

Main Entry: **pen·e·trate** ▶

Pronunciation: 'pe-n&-'trAt

Function: *verb*

Inflected Form(s): **-trat·ed**; **-trat·ing**

Etymology: L *penetratus*, past participle of *penetrare*, from *penitus* deep within, far; akin to Latin *penuis* provisions *transitive senses*

1 **a** : to pass into or through **b** : to enter by overcoming resistance : **PIERCE** **c** : to gain entrance to

2 **a** : to see into or through **b** : to discover the inner contents or meaning of

3 : to affect profoundly with feeling

4 : to diffuse through or into

*intransitive senses*

1 **a** : to pass, extend, pierce, or diffuse into or through something **b** : to pierce something with the eye or mind

2 : to affect deeply the senses or feelings

**synonym** see **ENTER**

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